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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,397	02/12/2004	Fatima M. Mayer	D/A3302	5783
7590	08/29/2006			
Patent Documentation Center Xerox Corporation Xerox Square 20th Floor 100 Clinton Ave. S. Rochester, NY 14644			EXAMINER RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/777,397

**Applicant(s)**

MAYER ET AL.

**Examiner**

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,6-8,13-15,17-19,22 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-8,13-15,17-19,22 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7, 13-15, 17-19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamano *et al.* in US Patent 6,500,594 in view of JP 06-180511.

This rejection was presented in the last Office action. Applicants have amended the claims to require stearyl stearamide as the alkyl stearamide of the toner. Applicants take the position that the references do not teach the use of stearyl stearamide in a toner (see response p. 6).

The Examiner has carefully reviewed the art of record but cannot agree with applicants' position. The JP document discloses a toner containing acid amide releasing agents have the formula R1-CONH-R2 where R1 and R2 are 9 to 21 carbon atom alkyl chains. Various alkyl acid amide releasing agents are disclosed in the JP document, including stearyl octadecanamide (¶ [0009]). This appears to be an alternative name for stearyl stearamide. In any event, the general teaching of the JP document includes various alkyl chain lengths of from 9 to 21 carbon atoms, which would include chains of 18 carbon chain length, particularly when chains of this length are disclosed.

The rejection is still proper because it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the alkyl acid amide of the JP document as the releasing agent in the Hamano because Hamano calls for acid amide releasing agents and the JP document discloses such a compound that not only has reduced offset but also

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minimizes deterioration of flowability and transferability during copying. It would also have been obvious to use a other alkyl acid amides from the specific teachings and general disclosure of the JP document with alkyl chain lengths within the range taught and particularly near those exemplified in ¶ [0009] to optimize the offset reduction effects.

Claims 1, 6-8, 13-15, 17-19, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sacripante *et al.* in US Patent 6,140,003 in view of JP 06-180511.

This rejection was also presented in the last Office action, and the above-discussed amendment in the recent response is also effective to these claims. Applicants take the position that the references do not teach the use of stearyl stearamide in a toner (see response p. 6).

As discussed above, the supporting JP document discloses various alkyl acid amide releasing agents, including stearyl octadecanamide (¶ [0009]). This appears to be an alternative name for stearyl stearamide. In any event, the general teaching of the JP document includes various alkyl chain lengths of from 9 to 21 carbon atoms, which would include chains of 18 carbon chain length, particularly when chains of this length are disclosed.

It still would have been obvious to one having ordinary skill in the art at the time the invention was made to use the alkyl acid amide of the JP document as the releasing agent in the Sacripante because Sacripante calls for releasing agents and the JP document discloses alkyl amide releasing agent compounds that not only has reduced offset but also minimizes deterioration of flowability and transferability during copying. It would also have been obvious to use other alkyl acid amides from the specific teachings and general disclosure of the JP document with alkyl chain lengths within the range taught and particularly near those exemplified in ¶ [0009] to optimize the offset reduction effects.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sacripante *et al.* in US Patent 6,017,671 in view of JP 06-180511.

Sacripante discloses a toner comprising a sulfopolyester having a number-average molecular weight of from 20,000 to 75,000, a weight-average molecular weight of from 25,000 to 125,000, and a polydispersity of 1.8 to 17 (col. 13, l. 63 – col. 14, l. 30). The toner also contains a colorant and an optional wax (Abstract). The wax is present in an amount of from about 1 to about 15 weight percent (col. 17, l. 29-52). Sacripante does not disclose stearyl atearamide as the wax for the toner but, the JP document teaches that acid amide releasing agents are effective to prevent offset and winding of paper at the time of fixing while also minimizing deterioration of flowability and transferability. The acid amide releasing agents have the formula  $R_1\text{-CONH-R}_2$  where  $R_1$  and  $R_2$  are 9 to 21 carbon atom alkyl chains. Various alkyl acid amide releasing agents are disclosed in the JP document, including stearyl octadecanimide (¶ [0009]). As discussed in the JP document, these alkyl acid amides are effective with various binder resins, including polyesters (¶ [0010]).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the alkyl acid amide of the JP document as the releasing agent in the Sacripante because Sacripante calls for waxes, which are known to function as releasing agents, and the JP document discloses alkyl amide releasing agent compounds that not only has reduced offset but also minimizes deterioration of flowability and transferability during copying. It would also have been obvious to use other alkyl acid amides from the specific teachings and general disclosure of the JP document with alkyl chain lengths within the range taught and particularly near those exemplified in ¶ [0009] to optimize the offset reduction effects.

### **Conclusion**

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cdr  
24 August 2006



CHRISTOPHER RODEE  
PRIMARY EXAMINER